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Remarks:

Regarding the rejection of claims 1-10 under 35 USC 103(a) as allegedly being unpatentable in view of U.S. Patent No. 6,669,763 to Ghodoussi et al. (hereinafter "Ghodoussi") in view of EP 0392316 to Leacock:

The applicants thank the Examiner for withdrawing the prior rejection of all prior claims in view of the combined Ghodoussi and Leacock references.

Regarding the rejection of claim 7 under 35 USC 101, and 35 USC 112:

In this paper, claim 7 have been amended to recite positive method steps, and is believed to fully address and overcome the grounds of rejection.

Regarding the rejection of claims 1-10 under 35 USC 103(a) as allegedly being unpatentable in view of US 2003/109395 to Neumiller (hereinafter "Neumiller"), in view of U.S. Patent No. 6,669,763 to Ghodoussi et al. (hereinafter "Ghodoussi") further in view of EP 0392316 to Leacock (hereinafter "Leacock").

The applicant traverses the Examiner's ground of rejection in view of the combined Neumiller, Ghodoussi and Leacock references.

The Examiner is respectfully reminded that applicants had previously amended the independent claim to comprise the transitional term "... *consisting essentially of*.." which incurs specific limitations as to the scope of the claimed invention. See MPEP, Section 2111.03. which in pertinent part reads:

The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) [...] "A 'consisting essentially of' claim occupies a middle ground between closed claims that are written in a 'consisting of' format and fully open claims that are drafted in a 'comprising' format." *PPG Industries v. Guardian Industries*, 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-54 (Fed. Cir. 1998). See also *Atlas Powder v.*

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E.I. duPont de Nemours & Co., 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); *In re Janakirama-Rao*, 317 F.2d 951, 137 USPQ 893 (CCPA 1963); *Water Technologies Corp. vs. Calco, Ltd.*, 850 F.2d 660, 7 USPQ2d 1097 (Fed. Cir. 1988).

In the present rejection the Examiner introduces the Neumiller reference as against the claims of the invention.

In light of the currently amended claims, the Applicants believe that the additional consideration of the Neumiller reference is inappropriate. Neumiller, summarizes his invention as follows:

SUMMARY OF THE INVENTION

[0017] This invention relates to an acidic cleaning formulation for cleaning hard surfaces comprising: (a) a surface modification agent selected from the group consisting of (i) a hydrolyzed trialkoxysilane in an amount from about 0.00001 to about 10.0 percent by weight of the formulation and (ii) a hydrolyzable quaternary silane in an amount from about 0.00001 to about 10.0 percent by weight of the formulation; (b) a surfactant in an amount from about 0.00001 to about 10.0 percent by weight of the formulation, provided that if the surface modification agent is a hydrolyzable quaternary silane then the surfactant is not a quaternary ammonium compound or sulfobetaine; (c) at least one alcohol having 1 to 12 carbon atoms; and water. Preferably, the hydrolyzed trialkoxysilane is formed in an aqueous emulsion from a hydrolyzable trialkoxysilane compound emulsified in water with about 5 to 100 percent by weight of an emulsifier based on the weight of the hydrolyzable trialkoxysilane and the surfactant is different than the emulsifier. In this preferred embodiment, the emulsifier

employed to emulsify the hydrolyzable trialkoxysilane must be in an amount effective to keep the hydrolyzable trialkoxysilane in a substantially totally hydrolyzed state while simultaneously inhibiting appreciable self-condensation of the silane in the aqueous emulsion. The formulation has a pH less than 7.0 which is generally attained by the addition of an acid. Preferably, the alcohol is a mono, di or tri hydric alcohol. The formulation may also include glycol ethers, solvents, fragrances and any other components well known to those skilled in the art of cleaning formulations.

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As is evident from a review of the foregoing, essential constituents to Neumiller's compositions include "(a) a surface modification agent selected from the group consisting of: (i) a hydrolyzed trialkoxysilane in an amount of from about 0.0001 to about 10.0 percent by weight of the formulation and (ii) a hydrolysable quaternary silane in an amount of from about 0.0001 to about 10.0 percent by weight of the formulation; ..."

With respect now to the currently amended claims, the presence of silicone containing compounds has now been expressly excluded from the claimed compositions. Support for this limitation is found in the applicants specification, *inter alia* at para. [0005], [0026] of the published specification. Thus, it is believed that the Examiner's additional reliance upon the Neumiller reference is inappropriate in view the currently presented claims. With the relevance of the Neumiller reference now superseded by the presently amended claim, it is believed to be quite clear that the Neumiller provides no further basis for rejecting essentially the same claims which were previously allowed by the Examiner over the Ghodoussi and Leacock references. Accordingly in view of the foregoing it is believed that the currently presented claims are similarly allowable over all the prior art of record, and the Examiner is requested to again allow the claims.

In view of the foregoing, reconsideration and withdrawal of this rejection are respectfully requested.

Should the Examiner in charge of this application believe that telephonic communication with the undersigned would meaningfully advance the prosecution of this application, they are invited to call the undersigned at their earliest convenience.

The early issuance of a *Notice of Allowability* is solicited.

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PETITION FOR A ONE-MONTH EXTENSION OF TIME

The applicant respectfully petitions for a one-month extension of time in order to permit for the timely entry of this response. The Commissioner is hereby authorized to charge the fee to Deposit Account No. 14-1263 with respect to this Petition.

CONDITIONAL AUTHORIZATION FOR FEES

Should any further fee be required by the Commissioner in order to permit the timely entry of this paper, the Commissioner is authorized to charge any such fee to Deposit Account No. 14-1263.

Respectfully Submitted;


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27 October 2009
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CERTIFICATION OF TELEFAX TRANSMISSION:

I hereby certify that this paper is being telefax transmitted to the US Patent and Trademark Office to telefax number: 571-272-8300 on the date shown below:


Jasmin Thiel

27 October 2009
Date

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